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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,559	02/06/2004	Hiromichi Kobayashi	1217-040223	3556
28289 7590 05/19/2008 THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219				
EXAMINER				
LE, HOA VAN				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
05/19/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/773,559

**Applicant(s)**

KOBAYASHI ET AL.

**Examiner**

Hoa V. Le

**Art Unit**

1795

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 17-19, 32-38, 40-51, 53 and 56-58 is/are pending in the application.
- 4a) Of the above claim(s) 1-15, 32-38 and 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-19, 40-50, 53 and 56-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

This is in response to Papers filed on 03/10/08.

I. The amendment filed 03/10/08 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The newly deleted and added materials in the instant specification that is not shown to be supported by the priority Japanese document No. 2003-31407 filed on 02/07/2003.

A certified English language translation of a pertinent portion to support for the mistakes as now amended for corrections is requested and required for a close and careful consideration and examination.

For a new matter issue, please see the authority in at least *Tronzo v. Biomet Inc.*, 4 USPQ 2d 1403.

An allowed specification or patent would have no value when someone is reasonably shown that there is not the same specification or patent as compared to that in the priority Japanese document specification. One should be carefully looked in to this issue because a benefit could be found and obtained.

II. The specification as now amended is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The specification as now amended contains subject matter which was not described in the priority Japanese document No. 2003-31407 filed on 02/07/2003.

The newly deleted and added materials in the instant specification that is not shown to be supported by the priority Japanese document No. 2003-31407 filed on 02/07/2003.

A certified English language translation of a pertinent portion to support for the mistakes as now amended for corrections is requested and required for a close and careful consideration and examination.

III. A careful studying of the instant specification unveils that the newly inserted “soft ferrite material” embodiment by applicants with their assignee and counsel support in to claim 17 is on page 4, line 20 to page 5, line 9 of the instant application under “BACKGROUND OF THE INVENTION” only. There is no support for the newly inserted “soft ferrite material” embodiment in to claim 17 in “SUMMARY OF THE INVENTION”, “DETAIL DESCRIPTION OF THE INVENTION” or Examples (not Comparative Examples) of the instant application. In the absence of convincing evidence that Examples (not

Comparative Examples) in the instant application are not “soft ferrite material” embodiment as newly inserted in to independent claim 17, there is no objection or rejection of a new matter for now until someone reasonably shows that at least one of Examples (not Comparative Examples) in the instant application is not “soft ferrite material” embodiment as newly inserted in to independent claim 17 by applicants with their assignee and counsel support.

IV. The record shows that there is an issue of new matter (being raised in the Office action mailed on 10/01/07) as added to independent claims 17 as made by applicants with their assignee and counsel support in the amendment filed on 09/24/07. Applicants have not convincingly provided a support for a complete record. In the absence of showings a convincing support as clearly pointed out and set forth on the record, the instant specification, independent claim 17 and its dependent claims are not in a condition for an allowance.

V. The record shows that multiple amendments have been made. The Office is trying to work very hard. However, there are so much issues for examinations that can be possibly done. Especially, applicants their assignee and counsel do not provide a support by clearly point out page and line in the

specification. One should be carefully looked in to an issue of new matter for each of the amended embodiment because a benefit may be found and obtained.

Applicants, assignee and their counsel must be fully provided a support for each of a raising new matter for each of the amended embodiment when someone has a question. Otherwise, a specification or claim has no value. Applicants and their assignee and counsel are urged and should choose to provide a clear record of a support for a complete consideration and examination now while the examinations of all issues are on considerations.

VI. Claims 17-19, 40-50 and 53, 56-58 are rejected under 35 U.S.C. 103(a) as obvious over Ikeda et al (2003/0122918) considered in view Yamane et al (5,637,431), Takiguchi et al (6316,156) or Kukimoto et al (6,548,218) for a newly added  $\text{Bi}_2\text{O}_3$ .

Ikeda et al disclose, teach and suggest a resin coated carrier core. The core comprises more than two groups of metal oxides, especially with one or more metal oxide groups of  $\text{TiO}_2$  and  $\text{ZrO}_2$ . For further details, please also see the whole disclosure of the applied reference, especially at least paragraphs 0056, 0061, 0066 to 0072, 0115, 0116, 0247 The language "...independent...", "melting point of not higher than  $1000^\circ\text{C}$ " "melting point of not lower than  $1800^\circ\text{C}$ " or "electrical resistivity...", "Hc of ...not more than 50 Oe", "soft ferrite material" or the like is a functional property or a measurement of a

functional property of a material and considered inherent. For a patentability of a property or measurement of a property of a material, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence. An allowed claim or patent would have no value when someone shows to the same or obviously about the same property as set forth on the record using all possible combinations of the teachings and suggestions in the applied references.

Ikeda et al as newly amended do not specify  $\text{Bi}_2\text{O}_3$  as newly added. However, it is known in the art at the time the invention was made to use  $\text{Bi}_2\text{O}_3$  in a carrier for an advantage of controlling an electrical resistance. Evidence can be seen in one of Yamane et al at col.7:9-11, Takiguchi et al at col.9:18-20 or Kukimoto et al at col.5:22.

Since the above references are all related to carriers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite for a reasonable advantage of controlling an electrical resistance as disclosed, taught and suggested by one of the secondary references.

Applicant's arguments filed 03/10/08 have been fully considered but they are not persuasive.

Applicants recognize that Ikeda et al disclose, teach and suggest the use of  $V_2O_5$  as that in the instant application and hurriedly amend, change and alter the specification.

For a newly added , please see the teachings, suggestions and citations with column and line in each of the applied references in the above rejection.

The arguments to Examples have been carefully considered but are given a little to no value since they are related to the issue of new matter until applicants and their assignee and counsel provide an evidence to the contrary as clearly pointed out and set forth on the record.

VII. Claims 17-19, 40-50 and 53, 56-58 are rejected under 35 U.S.C. 103(a) as obvious over Uchida et al (5,874,019) considered in view Yamane et al (5,637,431), Takiguchi et al (6316,156) or Kukimoto et al (6,548,218) for a newly added  $Bi_2O_3$ .

Uchida et al disclose, teach and suggest a resin coated carrier core. The core comprises more than two groups of metal oxides, especially with one or more metal oxide groups of  $TiO_2$  and  $ZrO_2$  . For further details, please also see the



whole disclosure of the applied reference, especially at least col.4:64-66, 6:10-12, 11:15, The language "...independent...", "melting point of not higher than 1000°C" "melting point of not lower than 1800°C" or "electrical resistivity...", "Hc of ...not more than 50 Oe", "soft ferrite material" or the like is a functional property or a measurement of a functional property of a material and considered inherent. For a patentability of a property or measurement of a property of a material, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence. An allowed claim or patent would have no value when someone shows to the same or obviously about the same property as set forth on the record using all possible combinations of the teachings and suggestions in the applied references.

Uchida et al as newly amended do not specify  $\text{Bi}_2\text{O}_3$  as newly added. However, it is known in the art at the time the invention was made to use  $\text{Bi}_2\text{O}_3$  in a carrier for an advantage of controlling an electrical resistance. Evidence can be seen in one of Yamane et al at col.7:9-11, Takiguchi et al at col.9:18-20 or Kukimoto et al at col.5:22.

Since the above references are all related to carriers, it would have been obvious to one having ordinary skill in the art at the time the invention was

made to use or cite for a reasonable advantage of controlling an electrical resistance as disclosed, taught and suggested by one of the secondary references.

VIII. Claims 17-19, 40-50 and 53, 56-58 are rejected under 35 U.S.C. 103(a) as obvious over Baba et al (6,165,663) considered in view Yamane et al (5,637,431), Takiguchi et al (6316,156) or Kukimoto et al (6,548,218) for a newly added  $\text{Bi}_2\text{O}_3$ .

Baba et al disclose, teach and suggest a resin coated carrier core. The core comprises more than two groups of metal oxides, especially with one or more metal oxide groups of  $\text{TiO}_2$  and  $\text{ZrO}_2$ . For further details, please also see the whole disclosure of the applied reference, especially at least col.6:39, 52, 53, 10:37-40. The language "...independent...", "melting point of not higher than  $1000^\circ\text{C}$ " "melting point of not lower than  $1800^\circ\text{C}$ " or "electrical resistivity...", "Hc of ...not more than 50 Oe", "soft ferrite material" or the like is a functional property or a measurement of a functional property of a material and considered inherent. For a patentability of a property or measurement of a property of a material, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a

factual evidence. An allowed claim or patent would have no value when someone shows to the same or obviously about the same property as set forth on the record using all possible combinations of the teachings and suggestions in the applied references.

Baba et al as newly amended do not specify  $\text{Bi}_2\text{O}_3$  as newly added. However, it is known in the art at the time the invention was made to use  $\text{Bi}_2\text{O}_3$  in a carrier for an advantage of controlling an electrical resistance. Evidence can be seen in one of Yamane et al at col.7:9-11, Takiguchi et al at col.9:18-20 or Kukimoto et al at col.5:22.

Since the above references are all related to carriers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite for a reasonable advantage of controlling an electrical resistance as disclosed, taught and suggested by one of the secondary references.

IX. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

X. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hoa V. Le/  
Primary Examiner, Art Unit  
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